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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/801,401	CLEMENTS, JEHAN	
	Examiner	Art Unit	
	Nikolai A. Gishnock	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 November 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 March 2004 and 28 November 2007* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/28/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In response to Applicant's remarks, filed 11/28/2007, claims 1-20 are pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5-9, & 11-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Tonkin (US 6,134,568), hereinafter known as Tonkin.

3. Tonkin discloses a system and method for producing a storytelling book having a first set of one or more pages in diametric contraposition to a second set of one or more pages, comprising: operating a software program in a computer having subroutines for accepting input from a user (information is input specifying the arrangement of the document, 6:26-27): generating, using the software program, a first set of one or more pages from said input; and generating a second set of one or more pages from said input, wherein said second set of pages are to be oriented in diametric contraposition to said first set of pages (if a printed pages component specifies source pages 1-100 and double-sided printing, then 50 document pages are defined, with source page 1 {the first set of pages} being printed on the front side of the first document page in the group, source page 2 being printed on the back side of the first document page in the group {the second set of pages}, and so on, 10:64-11:3) [Claims 1 & 11].

4. Tonkin discloses wherein said first set of pages corresponds to figures and text input by said user, and said second set of pages is automatically generated by said software program

based on said first set of pages [Claims 2 & 12], and wherein said second set of pages includes a subset of the information included in said first set of pages [Claims 3 & 13] (image data is generated for the printed image components of the document, 11:7-30; step is repeated for each document component to be printed with information from the source file. The components might include, for example, printed pages, the front cover, the back cover, and in certain embodiments, tab pages, 11: 31-35; the second set of pages is understood to be generated from the same source file as the first set of pages, thus it is inherently a subset of those pages) [Claims 2, 3, 12, & 13].

5. Tonkin discloses wherein said software program further comprises a subroutine for automatically displaying at least one page from said first set of pages and a second page from said second set of pages in diametric contraposition to each other (clicking on the image of the front cover advances to a view of the document as though a single page had been turned in the document. Figure 8B illustrates the results of this action, in which element 633 is an image of the back side of the front cover, and element 639 is an image of the front side of the first page after the front cover. Alternatively, the user can select any of the document components and advance immediately to that component, 12:23-52) [Claims 5 & 14].

6. Tonkin discloses wherein said software program further comprises: a subroutine for automatically generating first indicia on one or more of said pages, said first indicia indicating how to place leaves containing said first and second sets of pages in diametric contraposition to each other (If the document is to be in an open position, and assuming the document is bound on the left side, this will involve placing the image of the back side of one page so that its right edge is adjacent to the left edge of the front side of the next succeeding page in the document, with the exact spacing between the page edges specified by the display information associated with the selected binding. For certain types of binding (e.g., perfect binding) there will be little or

no spacing between the page edges, while for other types (e.g., coil binding) there will be a noticeable gap between the adjacent page edges, 11:49-65; this binding and spacing indicia is understood to all be displayed on the pages in the document view as above) [Claims 6 & 15].

7. Tonkin discloses wherein said first indicia include binding instructions (fields allow a user to specify the side which is to be bound (e.g., left side or top side), the type of binding to use (e.g., coil, tape, or perfect binding), and binding color respectively, 7:39-46) [Claims 7 & 16], page numbers (printed pages editing window includes fields for specifying a range of pages from the source file to be printed, 8:11-13) [Claims 8 & 17], and graphical symbols (the image of each production component preferably is in bitmap format, but also may be stored in any other format and may be either compressed or uncompressed, 9:20-23; a bitmap is understood to be a graphical symbol) [Claims 9 & 18].

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 4, 10, 19, & 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin, in view of Clements (US 6,210,172 B1), hereinafter known as Clements '172.

11. Tonkin teaches all the features as demonstrated above in the rejection of claim 1. What Tonkin fails to teach is wherein said first set of pages includes text and figures, and said second set of pages includes figures corresponding to said figures included on said first set of pages, and said second set of pages does not include text corresponding to said text included on said first set of pages [Claim 4]. However, Clements '172 teaches a storytelling book composed of a first or facing side of an "a" side set of pages including a graphic or illustration of a portion of a story, with the "a" sides together and successively illustrating the story, without words and printed text, and a second or back side of a "b" side set of pages including the graphics and illustrations being identical or closely corresponding to the facing {"a" side} graphic or illustration (4:11-30). The system and method for previewing and assembling a document of Tonkin would be used to produce the storybook, having an "a" set of pages including identical or closely corresponding graphics and illustrations as a "b" set, but not including the corresponding words or printed text, of Clements '172. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the invention of Tonkin to produce the storytelling book having diametrically opposed story pages, having sets of pages with identical illustrations but with one set omitting the narrative, as taught by Clements '172, in order to easily allow a user to specify, preview, and remotely produce the storybook document in volume [Claim 4].

12. Tonkin teaches a system and method for producing a storytelling book having a first set of one or more pages in diametric contraposition to a second set of one or more pages, comprising: a software program for generating said first and second sets of pages from user input (10:64-11:3); and a blank book for insertion of said first and second sets of pages (the

person constructing the document can view images of the document to obtain a sense of how the finished product is supposed to look, 14:35-50) [Claim 19], and wherein said software program further comprises a subroutine for automatically generating first indicia on one or more of said pages, said first indicia indicating how to place leaves containing said pages in diametric contraposition to each other (11:49-65) [Claim 20]. What Tonkin further fails to explicitly teach is where the device is a kit [Claims 19 & 20]. However, although the word "kit" does not appear in the prior art reference, the reference is reasonable understood to be a kit, because Tonkin teaches that the document is assembled according to the {software} document specification, and that document assembly techniques are well-known in the art and can be entirely manual, or partially or fully automated (Tonkin, 14:30-33). Because the software and the blank book are meant to be used together to assemble a storybook, one of ordinary skill in the art could reasonable interpret the invention of Tonkin to be a kit. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have provided the software and blank book for assembling a storybook of Tonkin as a kit, in order to provide a reliable technique for developing a "do-it-yourself" storybook [Claims 19 & 20].

13. What Tonkin further fails to teach is wherein said first indicia correspond to second indicia on leaves of a blank book [Claims 10 & 20]. However, Clements '172 teaches where the original and corresponding insertion pages may simply be affixed to a blank background surface, which is provided in {a} book to form pages (6:49-67). The system and method for previewing and assembling a document in a blank book, as taught by Tonkin, would be used to produce the storybook, having pages which are produced and then inserted into a clear loose-leaf holder provided in a blank book, as taught by Clements '172. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the invention of Tonkin to produce the storytelling book having said first indicia correspond to

second indicia on leaves of a blank book, as taught by Clements '172, in order to easily allow a user to arrange a "do-it-yourself" storybook, related to an audience by the creator of a story [Claims 10 & 20].

Response to Arguments

14. Applicant's arguments filed 11/28/2007, see pages 5-11, have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, see pages 6-9, it is noted that the features upon which applicant relies (i.e., a layout whereby "[a]n audience listening to the story sees the illustrations on even-numbered pages, and the storyteller/reader sees the same illustrations and text on the next consecutive odd-numbered pages"; and, "[o]nce printed, the pages for the reader will be bound together with a horizontal binding...") are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As best understood by the Examiner, Tonkin teaches "a second set of pages oriented in diametric contraposition to said first set of pages", as recited in claims 1 & 11, and "a first set of one or more pages in diametric contraposition to a second set of one or more pages", as recited in claim 19, because Tonkin teaches a first set of even-numbered source pages printed on the front sides of document pages in the group, and a second set of odd-numbered source pages printed on the back sides of the document pages (10-64:11-3). Tonkin further teaches coil binding along the top side of a document (7:39-46). Tonkin thus clearly teaches "diametric contraposition" of pages as disclosed in Applicant's Specification. Additionally Clements '172 explicitly teaches a storytelling book composed of a first or facing side of an "a" side set of pages including a graphic or illustration of a portion of a story, with the "a" sides together and

successively illustrating the story, without words and printed text, and a second or back side of a "b" side set of pages including the graphics and illustrations being identical or closely corresponding to the facing {"a" side} graphic or illustration (4:11-30), which is also understood to be pages in diametric contraposition. It would have been obvious to use Tonkin's software to generate a printed booklet for storytelling in the fashion taught by Clements '172. Thus, the Applicant's argument is not persuasive.

15. In response to applicant's argument that there is no suggestion to combine the references, see pages 9-11, the Examiner recognizes that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Additionally, the Supreme Court has particularly emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," where, "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," *KSR International Co. v. Teleflex Inc. (KSR),* 550 U.S. ___, 82 USPQ2d at 1385 (2007). The focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on what such a person would have been reasonably expected to have been able to do in view of that knowledge. This is so regardless of whether the source of that knowledge and ability was documentary prior art, general knowledge in the art, or common sense. See MPEP 2142 (Rev. 6, Sept. 2007). In this case, the Examiner suggests a motivation for combining Tonkin and Clements '172 at page 7, paragraph 15 of Office Action mailed 8/29/2007. It would have been obvious to one of ordinary skill in the art, at

the time the invention was made, to have used the invention of Tonkin to produce the storytelling book having diametrically opposed story pages, having sets of pages with identical illustrations but with one set omitting the narrative, as taught by Clements '172, in order to easily allow a user to specify, preview, and remotely produce the storybook document in volume. Thus, the Applicant's argument is not persuasive.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Haggerty (US 2004/0115599 A1) discloses a method for teaching students how to read, in the context of a network-enabled computer system, a plurality of dual-sided flip books, wherein one side provides a lesson for a student, and the other side provides instructions for a tutor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolai A. Gishnock whose telephone number is (571)272-1420. The examiner can normally be reached on M-F 8:30a-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. A. G./
Examiner, Art Unit 3714
2/25/2008

/Ronald Laneau/
Supervisory Patent Examiner, Art Unit 3714
02/26/08